UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROBERT NOODELIJK

Appeal No. 2005-1214
Application No. 09/902,767

VACATUR AND REMAND

Before WILLIAM F. SMITH, ADAMS, and GRIMES, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

This appeal involves plant patent Application No. 09/906,688. The question raised in this appeal involves whether evidence of foreign sales of the claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing the plant, thereby creating a bar under 35 U.S.C. § 102(b). The Court of Appeals for the Federal Circuit considered that issue in In re Elsner, 381 F.3d 1125, 72 USPQ2d 1038 (Fed. Cir. 2004), and held in the affirmative. Id., at 1128, 72 USPQ2d at 1041. In so holding, the court stated that "[t]he foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art." Id., at 1131, 1038 USPQ2d at 1043. The court also stated that the record did not establish that "even if the interested public would readily know of the foreign sales, those sales

enabled one of ordinary skill in the art to reproduce the claimed plants without undue experimentation." Id. Thus, the court vacated the Board's decision and remanded the case for "further factual findings relating to the accessibility of the foreign sales of the claimed plants and the reproducibility of the claimed plants from the plants that were sold."Id.

In this case, the examiner is relying upon applicant's admission that the claimed plant was on sale in The Netherlands in 1998 as evidence that NL PBR CHR 2752, PL PBR CHO0048, and QZ PBR 970499 are enabled references. However, there is no evidence whether the sales were of the type that would be noticed by those of skill in the art. Nor has the other issue raised by the Federal Circuit in Elsner, whether the sales would enable one skilled in the art to reproduce the claimed plant without undue experimentation, been addressed.

Accordingly, we vacate the examiner's rejection and remand the case to the examiner to determine whether the sales of the claimed plant (1) were "an obscure,

solitary occurrence that would go unnoticed by those skilled in the art" and (2) would enable one to reproduce the plant without undue experimentation.

VACATED; REMANDED

William F. Smith
Administrative Patent Judge

Donald E. Adams
Administrative Patent Judge

Eric Grimes
Administrative Patent Judge

) BOARD OF PATENT
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